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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,986	11/25/2003	Dana Ward	KOZ001	6986

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EXAMINER

BRITTAIN, JAMES R

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/721,986	Applicant(s) WARD, DANA	
	Examiner James R. Brittain	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 21-24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 21-24 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawing Objections

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the decorative card and currency holder comprising an elastic loop wherein the loop is formed from an elastic member, with a first end of the elastic member affixed to a first side of the charm and a second end of the elastic member affixed to a second side of the charm with the loop being a continuous loop as set forth in claim 28 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 28 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 21 has been amended to state that the decorative card and currency holder comprises an elastic loop wherein the loop is formed from an elastic member, with a first end of the elastic

Art Unit: 3677

member affixed to a first side of the charm and a second end of the elastic member affixed to a second side of the charm. This is consistent with the specification as set forth in [0022], which discusses the two ends that are joined to form a loop and is in contrast to the specification as set forth in [0021], which discusses the continuous loop without reference to ends being joined to the charm. Claim 21 is therefore no longer generic, but specific to those species with a non-continuous loop, i.e. the loop has two ends with the ends joined by the charm. Claim 28 contains new matter because it mixes the species as originally filed and indicates that the loop is continuous and there is no basis in the application as filed for determining the structure of a decorative card and currency holder with the loop having ends affixed to side of the charm and also being of a continuous construction.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by May (US 5680679).

May (figures 1, 9-11) teaches bracelet structure 400 inherently usable to hold money comprising an elastic loop 413 of a size to securely fit around and hold a quantity of currency, a charm attachment device 434, 442, 436 attached to the elastic loop, and a charm 448 attached to the charm attachment device, wherein the bracelet comprising a money holder is adapted to fit around a quantity of currency. In regard to claim 2, the money holder includes a covering

Art Unit: 3677

comprising a sheath 425 made of knitted fabric. As to claim 3 and 5, the key holder 448 is removably attached to the charm attachment device. In regard to claim 4, the charm attachment device 434 is crimped onto the elastic loop via the sheath ends 428. In regard to claim 4, the elastic loop comprises one side member in the form of the sheath and the central core elastic member.

Claims 21, 23 and 24 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Knickle (US 5279019).

Knickle (figures 1-5) teaches decorative card and currency holder structure comprising an elastic loop 12, wherein the loop is configured to securely hold currency, and a charm 20 having an opening there through, the opening receiving there through the loop wherein the card and currency holder is adapted to fit around the currency. The opening is formed by the top section 22 and the folded over flaps 28. The charm 20 is fixedly secured to the loop and the two ends of the elastic member are secured together within the folded over charm 20.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knickle (US 5279019) in view of May (US 5680679).

Knickle (figures 1-5) teaches decorative card and currency holder structure comprising an elastic loop 12, wherein the loop is configured to securely hold currency, and a charm 20 having

Art Unit: 3677

an opening there through, the opening receiving there through the loop wherein the card and currency holder is adapted to fit around the currency. The opening is formed by the top section 22 and the folded over flaps 28. The charm 20 is fixedly secured to the loop and the two ends of the elastic member are secured together within the folded over charm 20. The difference is that the elastic member is not enclosed in a woven covering. However, May (figures 1, 9-11) teaches bracelet structure 400 inherently usable to hold money comprising an elastic loop 413 of a size to securely fit around and hold a quantity of currency, a charm attachment device 434, 442, 436 attached to the elastic loop, and a charm 448 attached to the charm attachment device, wherein the bracelet comprising a money holder is adapted to fit around a quantity of currency and the money holder includes a covering comprising a sheath 425 made of knitted fabric. It would have been obvious to modify the decorative card and currency holder of Knickle so that there is a covering made a woven material over the elastic in order to provide better coloring, improved aesthetics and less abrasion as taught by May. While May uses a sheath made of knitted fabric, it would have been obvious to utilize a woven material as such materials are well-known and full equivalent of the knitted material.

Claim 28 is rejected under 35 U.S.C. §103(a) as being unpatentable over Knickle (US 5279019) in view of Lehr (US 6230878).

Knickle (figures 1-5) teaches decorative card and currency holder structure comprising an elastic loop 12, wherein the loop is configured to securely hold currency, and a charm 20 having an opening there through, the opening receiving there through the loop wherein the card and currency holder is adapted to fit around the currency. The opening is formed by the top section 22 and the folded over flaps 28. The charm 20 is fixedly secured to the loop and the two ends of

Art Unit: 3677

the elastic member are secured together within the folded over charm 20. The elastic member can be formed with the ends sewn together (col. 3, line 65 - col. 4, line 1). The difference is that the loop is not continuous. However, Lehr (figures 2, 4) teaches a decorative card and currency holder structure comprising a continuous elastic loop 14, wherein the loop is configured to securely hold currency, and a charm 10 having an opening 24 therethrough, the opening receiving therethrough the loop, wherein the card and currency holder is adapted to fit around the currency. It would have been obvious to form the loop of Knickle so as to be continuous as taught by Lehr so as to have fewer steps in the assembly of the device.

Claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over Lehr (US 6230878) in view of Knickle (US 5279019).

Lehr (figures 2, 4) teaches a decorative card and currency holder structure comprising an elastic loop 14, wherein the loop is configured to securely hold currency or cards, and a charm 10 having an opening 24 therethrough so as to be attached to the loop, wherein the card and currency holder is adapted to fit around the currency and the charm is free to slide along the loop. The difference is that the charm is not carried by a charm attachment device. However, the use of a charm attachment device to carry the charm is old and well known and Knickle (figures 1-5) teaches decorative card and currency holder structure comprising an elastic loop 12, wherein the loop is configured to securely hold currency, and a charm 20 having an opening there through, the opening receiving there through the loop wherein the card and currency holder is adapted to fit around the currency. However, Knickle also teaches that a decorative ornament considered to inherently form a charm can have a pin that mounts the charm in an aperture in the top section (col. 4, lines 13-18) of the cover plate 20 that then forms the charm attachment

Art Unit: 3677

device. It would therefore have been obvious to modify the top section of the sliding plate of Lehr so as to have an aperture to receive the pin of a charm as taught by Knickle to be an alternative desirable manner of ornamenting a decorative card and currency holder.

Response to Arguments

Applicant's arguments filed December 7, 2005 have been fully considered but they are not persuasive.

Applicant argues that May does not use the word "elastic" and since May uses the word "resilient", this is somehow different from "elastic" and the claim should be allowed. This argument is completely without merit and it is unknown how applicant can assert that "elastic" is patentably distinct from "resilient". In response to applicant's argument that the device is "adapted to fit around currency" renders the claim patentably distinct from the device of May, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Clearly, an elastic loop sized to extend around a wrist can inherently extend around an appropriately sized bundle of currency.

As to Knickle as applied to claim 21, applicant argues that the ends of the loop are not attached to the sides of the charm. Clearly the ends are attached to the sides of the charm because the charm has is folded over the ends. There is nothing in claim 21 that requires the ends of the loop not to be attached and in fact applicant includes in claim 28 and even draws

Art Unit: 3677

attention to the fact in the arguments presented December 7, 2005 on page 6, lines 3-5 that the loop is continuous thereby making it clear that applicant includes in the scope of claim 21 having the ends of the loop joined together, though not necessarily continuous, just as disclosed by Knickle. Applicant's argument is narrower than the claim construction and is contrary the scope applicant clearly believes is within the coverage of claim 21.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

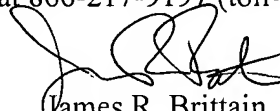
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (571) 272-7065. The examiner can normally be reached on M-F 5:30-2:00.

Art Unit: 3677

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB